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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,370	10/30/2001	Anthony David Peachman	072817.0141	9662

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EXAMINER

ST CYR, DANIEL

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/021,370

Applicant(s)

PEACHMAN ET AL.

Examiner

Daniel St.Cyr

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because in page 1, cross-reference section, line 2, --, now Patent No. 6,357,665-- should be inserted after "1998". Correction is required.

### ***Claim Rejections - 35 U.S.C. § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinagawa, US Patent No. 5,126,541.

Shinagawa discloses an integrated circuit card system in an IC card comprising a CPU, a ROM and an EEPROM, said system comprising: means for manufacturing said IC card and storing at the manufacturing in said ROM an operating system and programming instruction; means for personalization in said EEPROM an address table with memory address of at least one of said programming instruction, wherein the operating system will only access those program instructions in accordance with the addresses indicated in the address table (see col. 3, line 50 to col. 4, line 21; col. 7, line 60 to col. 8, line 3), wherein said programming instructions comprise at least one primitive (see col. 5, lines 16-25), wherein said programming instructions comprise at least one codelet (see figure 5; col. 5, lines 12-16), wherein said means for personalizing said IC card and for storing in said EEPROM further stores additional programming instructions (see col. 4, lines 44-48), and the primitives' names and the codelets' names are listed in the memory address (see figure 1).

### ***Double Patenting***

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4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-48 of U.S. Patent No. 6,357,665 (hereinafter '665 Patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed invention is a broader recitation of the '665 Patent. For instance in claim 1 of the instant application and the '665 Patent, the applicants claims:

i)" A secure multiple application card system including an IC card comprising a microprocessor, a read-only memory and an electrically erasable programmable read only memory, said system comprising: means for manufacturing said IC card and for storing at the time of manufacture in said read-only memory an operating system and programming instructions without an address table with memory address of at least one of said programming instructions; and means for personalizing said IC card after said manufacturing step and for storing at the time of personalization in said electrically erasable programmable read only memory said address table with memory address of at least one of said programming instruction, wherein the operating system will only access those programming instructions in accordance with the address indicated in the address table.",

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whereas in the '665 Patent, the applicants claim:

ii)” A secure multiple application card system including an IC card comprising a microprocessor, a read-only memory and an electrically erasable programmable read only memory, said system comprising: means for manufacturing said IC card and for storing at the time of manufacture in said read-only memory an operating system and a first set of programming instructions having a first address, without an address table with a second memory address of a second set of programming instructions; and means for personalizing said IC card after said time of manufacture and for storing at the time of personalization in said electrically erasable programmable read only memory said address table with the second memory address, wherein the operating system is incapable of accessing any set of programming instructions not having an address indicated in the address table, and wherein the address table is devoid of the first address such that the first set of programming instructions is rendered inaccessible after the time of personalization.”.

As to the claims 1-44 of the instant application, the '953 patent meets all the limitation as set forth in claims 1-48.

Thus, in respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims 1-48 of '665 patent as a general teaching for manufacturing IC cards, to perform the same function as claimed in the present invention. The instant claims obviously encompass the claimed invention of the '665 patent and differ only in terminology. The extent that the instant claims are broaden and therefore generic to claimed invention of '665 patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a

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generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from the claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. & 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. & 1.78(d).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamaguchi et al, US Patent No. 5,019,970, disclose an IC card. Tanka, US Patent No. 5,029,208, discloses a cipher distribution system. Fujioka, US Patent No. 5,206,938, discloses an IC card with memory area protection based on address line restriction. Geronimi, US Patent No. 5,542,081, discloses an IC card design to receive multiple programs in a programmable memory. Shelton et al, US Patent No. 6,035,380, disclose an integrated circuit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St. Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone numbers for the

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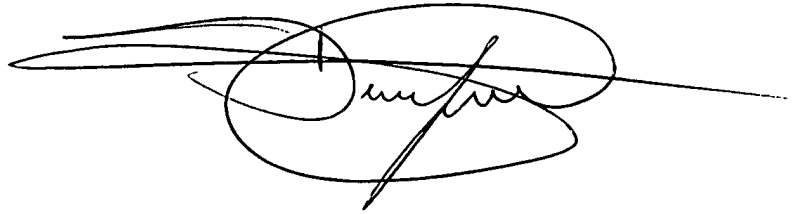
organization where this application or proceeding is assigned are 703-308-7721 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr  
Examiner  
Art Unit 2876

DS

May 18, 2002

A handwritten signature in black ink, appearing to read 'Daniel St. Cyr', is written over a large, loopy, circular scribble. The signature is fluid and cursive, with a long horizontal line extending to the right.